

REMARKS

Reconsideration of the application is respectfully requested. Claims 9-17, 19-25, and 28-37 are pending.

Examiner Interview Summary

Examiner Lawrence Ferguson is thanked for all courtesies extended to Applicant's counsel during the December 16, 2009 telephone interview with the Examiner. During the interview, the non-obviousness of the pending claims was discussed, particularly with respect to the claimed surface layer in view of the surface layers disclosed in Satani. *See* Satani at ¶¶32, 65, 66, 74-76, 80, and Table 2. Applicant's counsel also argued that Satani teaches away from the claimed invention by disparaging multilayer films having surface layers that contain more than 5 wt% polyethylene resin, and that one of ordinary skill in the art would therefore not have reasonably expected a multilayer film having a surface layer that contains more than 5 wt% polyethylene resin to be successful. *See, e.g.*, Satani at ¶¶32 and 80 (stating that multilayer films having surface layers that contain more than 5 wt% polyethylene resin have the undesirable property of low solvent sealing strength). These arguments are reiterated in further detail below. The Examiner agreed to reconsider the application in light of the arguments discussed during the interview.

Rejections Under 35 U.S.C. §103(a)

Claims 9-16, 19-25, and 28-37 have been rejected under 35 U.S.C. §103(a) as obvious over European Patent Application No. EP1270203 ("Satani"). Satani is cited by the Examiner as disclosing a heat shrinkable polyolefin film having three or more layers, including two surface layers, in which the mass ratio of cyclic polyolefin resin to polyethylene resin in each surface layer allegedly falls within the scope of the pending claims, and an intermediate layer in which polyethylene resin is a main component. According to the Examiner, it would have been obvious to make Satani's film with additional intermediate layers, as called for in the pending claims, and to

have polyethylene resin as a main component in the intermediate layers because the pending claims allegedly do not require a main component to be a cyclic olefin resin.

The rejection is traversed, and reconsideration is respectfully requested.

Claims 9-16, 19-25, and 28-37 are not obvious over Satani because, *inter alia*: (i) Satani teaches away from surface layers having the claimed amount of polyethylene resin; and (ii) Satani does not teach an intermediate layer in which a cyclic olefin series resin is the main component, as recited in the pending claims with respect to Intermediate layer (III).

First, the pending claims call for a surface layer comprising a mixed resin of a cyclic olefin series resin and a polyethylene series resin (A) in a mass ratio of 90/10 to 50/50. In other words, the polyethylene series resin (A) content in the claimed surface layer is about 10-50 mass %. In contrast, Satani discloses multilayer films in which cyclic olefin resin is the main component in the surface layer (“desirably included in an amount of 95% by weight or more”) and polyethylene resin is included “in an amount of 5% by weight or less.” See Satani at ¶32. Further, Satani expressly states that films containing more than 5 wt% polyethylene in the surface layer have undesirable properties, as follows (¶32, emphasis added):

In the resin materials of the surface layer, the cyclic olefin resin as the main component is desirably included in an amount of 95% by weight or more. For example, polyethylene resin can be mixed in an amount of 5% by weight or less. **If the resin is more than 5% by weight, the solvent sealing property decreases, which is not desirable.**

Satani’s Comparative Example 2 illustrates the undesirable consequences of having excess polyethylene (i.e., more than 5 wt%) in the surface layers of its films. Specifically, Comparative Example 2 relates to a heat-shrinkable polyolefin film in which the surface layer contains 80 wt% cyclic olefin copolymer resin and 20 wt% polyethylene resin. See Satani at ¶65-66. The solvent sealing strength of this comparative film was tested and found to be low, as indicated by the symbol “Δ” in Table 2 on page 8 of Satani. See Satani at ¶¶74-76 and Table 2; see also ¶80 (“the films of Comparative Examples 1 and 2 have a low ability for solvent sealing”). Given the foregoing, one of ordinary skill in the art would have read Satani as teaching away from films having a surface layer containing more than 5 wt% polyethylene resin because Satani shows that

surface layers having more than 5 wt% polyethylene resin have undesirable properties. Where a reference teaches away from the claimed invention, that reference cannot be relied upon to render the claimed invention obvious. *See In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1983); MPEP §2145(X)(D)(2)).

Additionally, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” MPEP §2143.01(III) (emphasis in original); *see also* MPEP 2143.02(I) (“The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success.”) *citing In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986). In other words, it is not enough for Satani to disclose that it is merely *possible* to make a film having more than 5 wt% polyethylene resin in the surface layers – one of ordinary skill in the art must have been able to reasonably predict that doing so would yield a successful product. Here, Satani teaches that a film containing more than 5 wt% polyethylene resin in a surface layer would be unsuccessful. Consequently, one of ordinary skill in the art would not have reasonably predicted that modifying one of Satani’s films to have the surface layer disclosed in Satani’s Comparative Example 2 (which contains 20 wt% polyethylene resin) would yield a successful product. On the contrary, one of ordinary skill would expect such a modification to be detrimental to the resulting product by lowering the solvent sealing strength of the film to an undesirable level.

Second, Satani does not disclose an intermediate film layer having the composition of Intermediate layer (III), as recited in the pending claims. Contrary to the Examiner’s assertion (*see* Office Action at pp. 6-7), all of the pending claims do indeed specify that a cyclic olefin series resin is the “main component” of Intermediate layer (III). For example, claim 9 recites (in relevant part; emphasis added):

9. A heat-shrinkable polyolefin series laminated film ... wherein each said layer (I), (II), and (III) comprises **as a main component** the following constituents:

...

Intermediate layer (III): a cyclic olefin series resin,

....

Independent claims 10 and 12 recite similar language indicating that a cyclic olefin series resin is the main component of the recited Intermediate layer (III). In contrast, Satani discloses a film having an intermediate layer comprised of a resin material containing a polyethylene resin as a main component, stating (§11, emphasis added):

A heat shrinkable polyolefin film according to the present invention is a laminate comprising surface layers composed of a resin material containing a cyclic olefin resin having a glass transition temperature of 50 to 75°C as a main component, and **an intermediate layer composed of a resin material containing a polyethylene resin as a main component**

See also Satani at ¶20. In short, Satani fails to disclose an intermediate layer comprising a cyclic olefin series resin as a main component, as called for in the pending claims. Moreover, one of ordinary skill in the art would not have reasonably predicted that changing the main component of Satani's intermediate layer from a polyethylene resin to a cyclic olefin series resin would yield a successful result. Satani is completely silent on this point. *See In re Burt*, 356 F.2d 115, 121 (CCPA 1966) ("Silence in a reference is hardly a proper substitute for an adequate disclosure of facts from which a conclusion of obviousness may justifiably follow.").

Given the foregoing, claims 9-16, 19-25, and 28-37 are not obvious over the cited reference. Therefore, Applicant respectfully requests that this rejection be withdrawn.

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Claim 17 has been rejected under 35 U.S.C. §103(a) as obvious over Satani in view of U.S. Patent No. 6,699,549 ("Ueyama"). The Examiner cites Satani for the reasons set forth above, but states that Satani does not disclose a layer comprising liquid paraffin. Ueyama is cited by the Examiner as disclosing the use of a liquid paraffin additive in an inner layer of a multilayer film. According to the Examiner, it would have been obvious to modify Satani's multilayer film to include liquid paraffin, as taught by Ueyama.

The rejection is traversed, and reconsideration is respectfully requested.

As set forth above, Satani fails to disclose (and, in fact, teaches away from) the surface layer of the claimed invention, and also fails to disclose a film having an intermediate layer in

which a cyclic olefin series resin is the main component. Ueyama does not cure the deficiencies of the primary reference because Ueyama likewise fails to disclose the features that are missing from Satani. Moreover, Ueyama provides no guidance that would have lead one of ordinary skill in the art to modify Satani's film to either increase the amount of polyethylene resin in the surface layer or to change the main component of an intermediate layer from a polyethylene resin to a cyclic olefin series resin. Thus, claim 17 is not obvious over the cited references for at least the same reasons advanced above. Accordingly, Applicant respectfully requests that this rejection be withdrawn.


Conclusion

In view of the above remarks, it is respectfully requested that the application be reconsidered, and that all the pending claims be allowed and the case passed to issue.

If there are any other issues remaining that the Examiner believes can be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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